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| IBM CORP (YA)<br>C/O YEE & ASSOCIATES PC<br>P.O. BOX 802333<br>DALLAS, TX 75380 |             |                      | EXAMINER<br>DUFFY, DAVID W |                  |
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* INTERNATIONAL BUSINESS MACHINES CORPORATION

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Appeal 2009-013050  
Application 09/941,251  
Technology Center 3700

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Before RICHARD E. SCHAFER, JAMESON LEE, and  
MICHAEL P. TIERNEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

A. STATEMENT OF THE CASE

Appellant, International Business Machines Corporation (“IBM”), the real party in interest, appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1-5, 7, 12, 13, 15, 21, 22, and 51. We have jurisdiction under 35 U.S.C. § 6(b). We *reverse*.

References Relied on by the Examiner

|                                    |                 |               |
|------------------------------------|-----------------|---------------|
| Kershaw et al. (“Kershaw”)         | 5,827,070       | Oct. 27, 1998 |
| Thomas                             | 5,885,087       | Mar. 23, 1999 |
| Hoehn-Saric et al. (“Hoehn-Saric”) | 5,915,973       | Jun. 29, 1999 |
| Sugimoto                           | US 6,755,661 B2 | Jun. 29, 2004 |

The Rejections on Appeal

The Examiner rejected claims 1-3, 12, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Thomas and Sugimoto.

The Examiner rejected claims 4, 5, 7, and 13 under 35 U.S.C. § 103(a) as unpatentable over Thomas, Sugimoto, and Admitted Prior Art.

The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as unpatentable over Thomas, Sugimoto, and Kershaw.

The Examiner rejected claim 51 under 35 U.S.C. § 103(a) as unpatentable over Kershaw, Thomas, Hoehn-Saric, and Sugimoto.

The Invention

The invention relates to a method in a data processing system for administering tests using customized user alerts. (Spec. 1:6-9.) In particular, when a test taker undertakes a test, an alert is generated for each test question which provides the test taker with certain time information for the test question, *e.g.*, the amount of time suggested for completing the

question and the time that has elapsed. Each of IBM's claims are directed to a method that involves establishing an "alert schedule" for periodically generating a "customized user alert" where the alert schedule is determined based on the content of a "customized alert profile." (App. Br. Claims App'x.)

B. ISSUE

Did the Examiner incorrectly determine that the prior art of record accounts for the features of IBM's claims directed to establishing an "alert schedule" for periodically generating a "customized user alert" based on a "customized alert profile," where the alert schedule is specific to a particular test question and also to a particular test taker?

C. PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of unpatentability based on the teachings of the prior art. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

D. FINDINGS AND ANALYSIS

Claims 1 and 51 are independent. Each of claims 1 and 51 is drawn to a computer-implemented method for monitoring responses to test questions presented in a data processing system. IBM argues claims 1 and 51 separately.

Claim 1

As a part of the method of claim 1, a "customized user alert" is periodically generated based on an "alert schedule." As set forth in the claim, the "customized user alert" is an indicator which provides information

to a test taker pertaining to the time remaining to answer a specific test question together with each of a suggested amount of time for the question and a total amount of time allotted to complete all questions of the test. The “alert schedule” is a schedule of the timing alerts that are generated and periodically presented to the test taker. The “alert schedule” is determined based on a “customized alert profile.” In claim 1, the “customized alert profile” includes (App. Br. 18-19 Claims App’x.):<sup>2</sup>

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<sup>2</sup> The entire text of claim 1 is as follows:

1. A computer-implemented method for monitoring responses to test questions presented in a data processing system, the method comprising the computer implemented steps of:

identifying presentation of the test questions on the data processing system;

responsive to the presentation of the test questions on the data processing system, monitoring test question timing data in which the test question timing data represents an elapsed time since an answered question from the test questions has been presented, wherein the elapsed time is an amount of time in attempting to answer a specific test question; and

generating a customized user alert after the test question timing data exceeds an alert threshold while continuing to present the specific test question for the test taker to answer, wherein the customized user alert apprises a test taker that the elapsed time is excessive for the specific test question, wherein the customized user alert is periodically presented to the test taker based on an alert schedule for the specific test question after at least one time period indicated by the alert schedule, wherein the customized user alert includes an amount of time remaining to answer the specific test question, a suggested amount of time to spend on the specific test question, and an amount of time allotted to complete all of the test questions, wherein the alert schedule is generated for the test taker based on a customized alert profile for the test taker, wherein the suggested amount of time to spend on the specific test question is calculated for the test taker based on the customized alert profile, and wherein the customized alert profile includes previous performance information of the test taker, information to associate a level of difficulty of the specific test question with a capability category of the test taker to answer the specific test question, and at least one alert threshold for each of the test questions.

previous performance information of the test taker, information to associate a level of difficulty of the specific test question with a capability category of the test taker to answer the specific test question, and at least one alert threshold for each of the test questions.

Thus, the “alert schedule” is determined based on stored characteristics particular to the test taker, *i.e.*, past performance information and a measure of the test taker’s capability, and particular to the test question, *i.e.*, the level of difficulty of each question. As described in IBM’s specification, the “alert threshold” is a specific time period for each question beyond which the customized user alert is generated and presented to the test taker. (Spec. 25:15-27.) IBM’s claims require that the content of the “customized alert profile” determines when a “customized user alert” is generated. The profile includes information on ability of the test taker and difficulty of each specific question. Thus, the alert schedule is both test taker specific and test question specific.

The Examiner rejected claim 1 over Thomas and Sugimoto. The Examiner found that Thomas discloses a system which provides timing information to a test taker. The Examiner stated that Thomas’ system maintains a profile of a test taker which provides a history of the test taker’s performance. (Ans. 3:17-4:1.) The Examiner determined, however, that Thomas does not describe that an “alert schedule” is established based on the content of a “customized alert profile” which includes information specific to each test question and each test taker as is required by claim 1. (*Id.* at 4:1-4.) Thomas describes simply that a “visual indication” of time information is “displayed” to a test taker for each question of a test. (Thomas 2:5-20.) Evidently in Thomas, no “alert schedule” is necessary as

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the time information for a question is displayed constantly for the duration the question is on display.

To make-up for the deficiency in Thomas, the Examiner relied on Sugimoto. Sugimoto discloses a system for performing an adaptive test in which a test taker is given a time limit to answer a question. (Sugimoto 1:45-48.) If the test taker answers the question in less than the time allotted, then the time remaining is added to the time limit for the next question of the test. (*Id.* at 1:53-67.) Sugimoto's system thus allows the test taker to reduce pressure they might feel from a particular question's time limit by more quickly answering a previous question. (*Id.* at 1:67-2:4.) In connection with conveying time information to the test taker, Sugimoto discloses simply that the act of "displaying on a display" the time remaining for a question occurs for each question. (*Id.* at 2:45-54.)

IBM argues that Sugimoto does not remedy the above-noted deficiency of Thomas. That is, IBM contends that neither Thomas nor Sugimoto accounts for the claim feature directed to periodically presenting alerts to a test taker based on a customized alert profile resulting in an alert schedule that is specific for each question and for each test taker.

IBM's argument is persuasive. The Examiner does not meaningfully explain how Sugimoto establishes that time information for a test question is displayed based on a "customized alert profile." In Sugimoto's disclosure, like in that of Thomas, timing information appears to be displayed constantly for the entire duration that each question is presented to a test taker. On the other hand, IBM's claim 1 requires that the alert schedule for any given question is customized based on each question and each user. That the timing information in each of Thomas and Sugimoto is continually

displayed for the entire duration that a question is presented to a test taker means that there is no periodic display of alerts based on an “alert schedule,” much less that the alert schedule is developed based on the characteristics of the test taker and the particular test question.

The Examiner bears the initial burden of presenting a prima facie case of unpatentability based on the teachings of the prior art. *In re Oetiker*, 977 F.2d at 1445. On this record, the Examiner has not adequately accounted for the feature of claim 1 directed to the periodic generation of customized user alerts on an alert schedule that is generated based on a customized alert profile. To the extent that there is even any alert schedule, it has not been shown to be either question specific or user specific. We do not sustain the rejection of claim 1 as unpatentable over Thomas and Sugimoto.

*Dependent claims 2-5, 7, 12, 13, 15, 21, and 22*

Claims 2-5, 7, 12, 13, 15, 21, and 22 are dependent on and include all the limitations of claim 1. Claims 2, 3, 12, 21, and 22 were rejected as unpatentable over Thomas and Sugimoto. We do not sustain the rejection of those claims.

With respect to claims 4, 5, 7, and 13, the Examiner rejected those claims as unpatentable over Thomas, Sugimoto, and Admitted Prior Art. The Examiner relies on Admitted Prior Art to account for features added by claims 4, 5, 7, and 13 and does not submit that the Admitted Prior Art makes up for the deficiencies discussed above in association with claim 1. We do not sustain the rejection of claims 4, 5, 7, and 13 over Thomas, Sugimoto, and Admitted Prior Art.

With respect to claim 15, the Examiner rejected the claim over Thomas, Sugimoto, and Kershaw. The Examiner relied on Kershaw to



account for features added by claim 15 and not to make up for the deficiencies noted above in connection with claim 1. We do not sustain the rejection of claim 15 over Thomas, Sugimoto, and Kershaw.

### Claim 51

Claim 51 is independent and was rejected over Kershaw, Thomas, Hoehn-Saric, and Sugimoto. Like claim 1, claim 51 is directed to a method in which a “customized user alert” is periodically generated based on an “alert schedule” that is developed based on a “customized alert profile.” (App. Br. 21-22 Claims App’x.) As set forth in claim 51, the “customized alter profile” is similar to that of claim 1 and includes (*Id.* at 22.)

previous performance information of the remotely located users, information to associated a level of difficulty of the specific test question with a capability category of the remotely located user to answer the specific test question, and a plurality of alert thresholds for each of the test questions[.]

Thus, claim 51 requires essentially the same features that are discussed above in connection with claim 1. Rather than a single alert threshold, however, claim 51 requires a plurality of alert thresholds.

The Examiner determined that the combination of Kerhsaw, Thomas, and Hoehn-Saric does not disclose the above-noted requirements of claim 51 and took the position that Sugimoto cures the deficiency. (Ans. 10:1-11:2.)

For essentially the same reasons given above with respect to claim 1, we reject the Examiner’s position. The Examiner has not adequately explained how Sugimoto’s disclosure of simply “displaying on a display” the time remaining for a question accounts for the above-noted features of claim 51.

For the foregoing reasons, we do not sustain the rejection of claim 51 over Kershaw, Thomas, Hoehn-Saric, and Sugimoto.

E. CONCLUSION

The Examiner incorrectly determined that the prior art of record accounts for the features of IBM's claims directed to establishing an "alert schedule" for periodically generating a "customized user alert" based on a "customized alert profile," where the alert schedule is specific to a particular test question and also to a particular test taker.

F. ORDER

The rejection of claims 1-3, 12, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Thomas and Sugimoto is reversed.

The rejection of claims 4, 5, 7, and 13 under 35 U.S.C. § 103(a) as unpatentable over Thomas, Sugimoto, and Admitted Prior Art is reversed.

The rejection of claim 15 under 35 U.S.C. § 103(a) as unpatentable over Thomas, Sugimoto, and Kershaw is reversed.

The rejection of claim 51 under 35 U.S.C. § 103(a) as unpatentable over Kershaw, Thomas, Hoehn-Saric, and Sugimoto is reversed.

REVERSED

Appeal 2009-013050  
Application 09/941,251

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